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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,677	03/15/2004	Satoshi Ozaki	249907US2RD CONT	8652
22850 7590 01/23/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER NGUYEN, TANH Q	
			ART UNIT	PAPER NUMBER
			2182	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		01/23/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/799,677

Applicant(s)

OZAKI ET AL.

Examiner

Tanh Q. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 and 11-20 is/are pending in the application.
- 4a) Of the above claim(s) 8,9 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11-18 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☒ Certified copies of the priority documents have been received in Application No. 09/704,606.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>03/15/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Invention I (claims 1-7, 11-18, 20) in the reply filed on October 30, 2006 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 8, 9, 19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim.
3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

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1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-7, 11-18, 20 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,721,811 (hereinafter US-811).

Claims 1-8 of US-811 claim all the limitations recited in claims 1-7, 18 of the instant application except for "means for transmitting the messages" (instead of "a message transmission unit configured to transmit the messages" - as recited in the claims of US-811). Since "means for transmitting the messages" is no more than a subset of "a message transmission unit configured to transmit the messages", and since it has been held that claiming a subset of a previously claimed set is obvious, it would have been obvious to one of ordinary skill in the art at the time the invention was made to claim a subset in the instant application in lieu of a previously claimed set that includes the subset.

Claims 1-8 of US-811 claim all the limitations recited in claims 11-17, 20 of the instant application except for "means for recognizing a particular network" (instead of "a determination unit configured to recognize a network" - as recited in the claims of US-811) and except for "means for determining communication methods" (instead of "a

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determination unit configured...to determine communication methods" - as recited in the claims of US-811). Since "means for recognizing a particular network" and "means for determining communication methods" represent no more than a subset of "a determination unit configured to recognize a network...and to determine communication methods", and since it has been held that claiming a subset of a previously claimed set is obvious, it would have been obvious to one of ordinary skill in the art at the time the invention was made to claim a subset in the instant application in lieu of a previously claimed set that includes the subset.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

8. Claims 1-7, 11-18, 20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

9. The specification does not provide clear support for "a registration unit configured to register a plurality of message servers distributed on a plurality of networks,

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according to a command of a user of the message processing device". The specification discloses that a reception POP server may be registered in advance, or specified when commanding a mail reception [page 17, lines 18-21], hence at best only discloses one message server being registered according to a command of a user of the message processing device. There is no clear evidence for a plurality of message servers being registered according to one command of the user of the message processing device.

10. Claims 1-7, 11-18, 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant invokes 35 USC 112, sixth paragraph in the remarks - with respect to "means for transmitting" recited in claims 1-7, 18; and with respect to "means for recognizing" and "means for determining" recited in claims 11-17, 20. Since the disclosure does not specify any means, and since applicant did not associate a structure with each of the respective means, it is not clear what each of the respective means encompasses. At best, FIG.2 merely shows a Message Delivery Transmission Unit 202a (MDTU), and a Message Presentation Unit 204 (MPU) being capable of transmitting, but there is no disclosure of a structure for MTDU 202a, or of a structure for MPU 204. Furthermore, the examiner did not find any support in the disclosure of a structure for a "means for recognizing", or of a structure for a "means of determining". Based on the above observations, it appears that applicant improperly invoked 35 USC 112, sixth paragraph.

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11. Claims 2-3, 12-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Each of claims 2, 12 recites "The message processing device...further comprising a second memory to store the messages...into an external memory device". It is not clear how a second memory of the message processing device can store the messages into an external memory device.

Claim 2 recites "a condition specified by the user", and claim 3 also recites "a condition specified by the user". It is not clear whether "a condition specified by the user" is the same condition specified by the user in claim 2. If the condition in claim 2 is the same as the condition in claim 3, then "a condition specified by the user" in claim 3 should be replaced with "**the** condition specified by the user". If the condition in claim 2 is not the same as the condition in claim 3, then the two conditions needs to be differentiated (e.g. replacing "a condition specified by the user" in claim 3 with "**another** condition specified by the user").

12. Claims 6, 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Each of claims 6, 16 recites ""a notification unit configured to notify an address of the message processing device to said another device". It is not clear what the limitation means. It appears that the notification unit is configured to notify the another device of an address of the message processing device.

13. The following rejections are based on the examiner's best interpretation of the claims.

***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

16. Claims 1-7, 11-18, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oberhaus et al. (US 6,983, 308), and alternatively over Oberhaus in view of Woo et al. (US 5,948,059).

17. As per claim 1, Oberhaus teaches a message processing device (a hand-held computing device for receiving e-mail [col. 1, lines 35-36]) which can be connected to



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different networks at different times (a hand-held computing device **can** be connected to different networks at different times), comprising:

a registration unit configured to register a plurality of message servers distributed on a plurality of networks, according to a command of a user of the message processing device (forwarding e-mail received in one mailbox to another mailbox, and synchronizing e-mail when manually requested by a user with multiple mailboxes [col. 1, lines 41-47], hence registering a plurality of message servers distributed on a plurality of networks according to a user command; note also that "multiple mailboxes" suggests more than two message servers);

a recognition unit configured to recognize a particular network to which the message processing device is connected (when the user synchronizes the e-mail from the hand-held computing device with a desktop computer over dedicated wires [col. 1, lines 47-50], it is necessary for the hand-held computing device to recognize the network comprising the desktop computer and the hand-held computing device to properly synchronize the e-mail; furthermore when e-mail are synchronized over network connection from a device, it is necessary for the device to recognize the network to which it is connected to, in order to ensure proper communication);

a first memory configured to store messages in the message processing device (a memory is necessary to store e-mail for access by the user);

a message collection unit configured to collect messages addressed to the user from the message servers and to store the messages into the first memory (when the user accesses the e-mail from the message servers, the e-mail addressed to the user

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are collected and stored on the hand-held device); and

means for transmitting the messages stored in the first memory, in response to a request from another device connected to the particular network (when a request is made to synchronize the e-mail from the desktop computer, the appropriate e-mail in the memory of the hand-held computing device are transmitted for synchronization).

Oberhaus discloses the invention except for determining communication methods for accessing the message servers, and except for collecting messages addressed to the user from the message servers using the determined communication methods.

It was known in the art at the time the invention was made to determine the communication methods for accessing message servers when accessing the message servers, and using the determined communication methods to properly receive and/or transmit the e-mail. It would have been therefore obvious to one of ordinary skill in the art at the time the invention was made to determine the communication methods of the message servers and using the communication methods in collecting the messages addressed to the user from the message servers, in order to ensure proper collection of the e-mail.

Woo teaches determining the communication methods for accessing message servers [102, 104 - FIG. 1; 214, FIG. 2; col. 3, lines 51-55] when accessing the message servers, and using the determined communication methods to receive and/or transmit the e-mail [col. 4, lines 46-49] - in order to store, retrieve, access and manage messages which are in different formats and different media types - regardless of the

form and the protocol used to manage and store the messages from any media available to the user (col. 2, lines 47-52].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to determine the communication methods of the message servers and using the communication methods in collecting the messages addressed to the user from the message servers, as is taught by Woo, in order to store, retrieve, access and manage messages which are in different formats and different media types - regardless of the form and the protocol used to manage and store the messages from any media available to the user.

18. As per claim 2, it was known in the art at the time the invention was made to store unprocessed messages from a first memory into an external memory device when the unprocessed messages exceed the capacity of first memory - in order to preserve the unprocessed messages for processing at a later time. It would have been obvious to one of ordinary skill in the art at the time the invention was made to store unprocessed messages into an external memory device according to the user specifying preserving the unprocessed messages when the capacity of the first memory is exceeded - in order to process the unprocessed messages at a later time.

19. As per claim 3, it was known in the art at the time the invention was made to delete messages that are no longer necessary to conserve memory space. It would have been obvious to one of ordinary skill in the art at the time the invention was made to delete the messages from the first memory and/or the external memory device once the messages are processed - according to the user specifying that the information is

no longer necessary, in order to save memory space.

20. As per claim 4, Oberhaus teaches synchronization of e-mail between two devices [col. 1, lines 45-50], hence teaches another device requesting synchronization with the message processing device. When the message processing device receives the request for synchronization from the another device, the message processing device processes the message according to the request for synchronization (functions) provided at the another device.

21. As per claim 5, it was known in the art at the time the invention was made to inquire a network domain of a particular network and use the network domain to determine whether a server is accessible to the particular network. It would have been obvious to one of ordinary skill in the art at the time the invention was made to inquire a network domain of the particular network, in order to use the network domain to determine message servers that are accessible to the particular network, from the registered message servers.

22. As per claim 6, it was known in the art at the time the invention was made for a message processing device to provide an address of a message stored on the message processing device (e.g. the source of the message stored on the message processing device) when a request for synchronization is received from another device, in order to allow the another device to determine the source of the message. It would have been obvious to one of ordinary skill in the art at the time the invention was made to notify the another device of an address of a message of the message processing device, in order to allow the another device to determine the source of the message, in response to a

request for synchronization (a form of inquiry) and to determine whether the message is appropriate for synchronization.

23. As per claim 7, Oberhaus teaches the message processing device being a hand-held computing device [col. 1, lines 35-36], hence storing the messages into the first memory in response to a user request entered from an input device of the hand-held computing device (the user of the hand-held computing device entering a request to access a message server), the hand-held computing device further comprising a display unit configured to display the messages stored in the first memory on a display screen associated with the message processing device, in response to a user request entered from the input device.

Furthermore, it was known in the art at the time the invention was made for a hand-held device to be equipped with a radio communication device (either built-in or externally connected) in order to allow the hand-held device to communicate wirelessly, and to improve user mobility. It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a radio communication device with the message processing device in order to allow the message processing device to collect the messages from wireless message servers, and in order to improve user mobility for the message processing device.

24. As per claim 18, Oberhaus teaches the another device being a desktop computer [col. 1, lines 45-50], hence the another device having an interface for viewing the messages. Oberhaus further teaches e-mail synchronization, hence the first memory maintaining the synchronized messages while and after the messages are viewed on

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the another device.

25. As per claims 11-17, 20, the claims generally correspond to claims 1-7, 18 and are rejected on the same bases.

### **Conclusion**

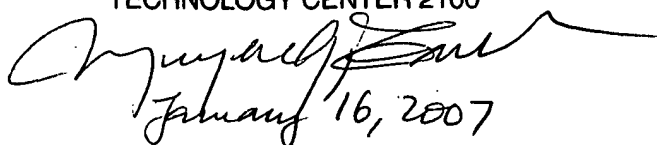
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tanh Q. Nguyen whose telephone number is 571-272-4154. The examiner can normally be reached on M-F 9:30AM-7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Huynh can be reached on 571-272-4147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TQN  
January 12, 2007

TANH Q NGUYEN  
PRIMARY EXAMINER  
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January 16, 2007